UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

54

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,231	03/02/2001	Eileen McKee	1120_003	6969

20874 7590 04/15/2004

WALL MARJAMA & BILINSKI
101 SOUTH SALINA STREET
SUITE 400
SYRACUSE, NY 13202

EXAMINER	
HOTALING, JOHN M	
ART UNIT	**PAPER NUMBER**
3713	10

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/681,231	MCKEE ET AL.	
	Examiner	Art Unit	
	John M Hotaling II	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48-73* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 48, 58, and 66 rejected under 35 U.S.C. 102(b) as being anticipated by Claypole et al GB Patent application 2,262,642. Claypole discloses on page 3 that his invention is a fruit machine with an additional screen with additional or secondary controls to play a feature of the fruit machine game. Slot machines are the same as fruit machines. The feature is provided to the player with respect to the performance (outcome) of the fruit machine. The feature is to provide a skill game on the secondary display. The machine comprises means providing a skill game feature which is played using the further display screen and which constitutes a "feature" with respect to the fruit machine game. The skill game, or various skill games, may be provided as awards depending on the performance of the fruit machine game of the reel display. With respect to the claim limitation of 3 contiguous related symbols the applicant and the reference teach that the outcome of the fruit machine, which is usually 3 symbols, advances the player to the bonus feature. See also applicant's specification paragraph 4 where 3 symbols are lined up in order to get to the bonus game. Claypole discloses that the skill game may be a quiz game, or a "video game" (page 4) involving dexterity and/ or timing. Page 4 and 5 discloses an array of fields that may be chosen by the

player and an award made. Page 8 discloses the use of touch screen technology for the secondary game. Page 9 and page 15 discloses that it will be understood that the design of the hardware and software to perform the functions of the games is generally within the skill of the skilled person in this field and does not need to be explicitly described. This is considered by the examiner to be an adequate disclosure of all of the memory portions used in a computer program since the functionality of all of the memory portions have been described. Page 14 discloses the player collecting winnings. Page 3 discloses

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 54, 64, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al GB Patent application 2,262,642 as applied to claims 48, 58, and 66 above in further view of Luciano, Jr. et al US Patent 6,050,895. Claypole discloses all of the instant application but lacks in disclosing the use of a joystick as an input device to control the video game in the second display to play a secondary game. Instead Claypole disclose that the game of skill or dexterity such as a "video game" may be used as the secondary feature. In an analogous gaming device to Luciano there is disclosed a gaming device that has a game of chance and that the outcome of the

chance game could result in a dexterity or video game. Column 3 discloses that a number of devices may be provided for permitting the user to control or provide input to the gaming terminal, such as buttons 114 a, b, c, a slot machine type handle, one or more joy sticks, cursor or other buttons and the like. Column 11:57-12:8 discloses two game machines coupled by communications means. One of ordinary skill in the art would have been motivated to look for additional game since claypole discloses that "video games" are ideally suited for the secondary display. It would have been obvious to one of ordinary skill in the art to combine Claypole with Luciano given the motivation above and the fact that both inventions are related to slot machines with secondary games being video games.

Claims 56, 57, 59-63, and 66-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al GB Patent application 2,262,642 as applied to 48, 58, and 66 above in further view of Luciano, Jr. et al US Patent 6,050,895 and Adamczyk et al US Patent 6,379,250. Claypole discloses all of the instant application as disclosed above but lacks in disclosing specific control of direction speed, spin or any combination of the three and the networking of gaming machines. Instead Claypole disclose that the game of skill or dexterity such as a "video game" may be used as the secondary feature. Luciano discloses that any of a plurality of video games may be used as a secondary feature and that the game machines may be connected to with communications means to permit players to play against each other in a simulated race, fighting game, or sports event. Luciano also discloses in column 3 discloses that a number of devices may be provided for permitting the user to control or provide input to

the gaming terminal, such as buttons 114 a, b, c, a slot machine type handle, one or more joy sticks, cursor or other buttons and the like. Column 5 discloses what qualifies as a dexterity game. Using the specifications as what qualifies as a dexterity or video game one of ordinary skill in the art would be motivated to combine Claypole and Luciano with Adamczyk in order to have a video game that uses a trackball that controls direction, speed, and spin and any combination of the three in a measurable way to provide an outcome for a bowling game as disclosed in column 4. Additionally, column 5 discloses that the game may be played alone, in a group, a team, or a league. The opponents may be in the alley with you, or in another location over a local area network, or in another city or country, such as over the internet. It would be obvious to one of ordinary skill in the art to combine the references above in order to have a secondary game that uses a trackball to measure any combination of direction, speed, and spin and be playable over a network.

Claims 55, 65, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al GB Patent application 2,262,642 as applied to claims 48, 58, and 66 above in further view of Dickinson et al GB Patent application 2,174,773. Claypole discloses all of the instant application but lacks in disclosing the use of a light pen as an input device to control the video game in the second display to play a secondary game. Instead Claypole disclose that the game of skill or dexterity such as a "video game" may be used as the secondary feature. Page 4 and 5 disclose a reveal matrix game and page 8 discloses that the use of touch screen technology can be used for the features of the game. In an analogous gaming device to Dickinson there is

disclosed a gaming device that has a reveal matrix game and the use of a light pen to make selections. One of ordinary skill in the art would have been motivated to look for additional game since Claypole discloses that skill are ideally suited for the secondary display. It would have been obvious to one of ordinary skill in the art to combine Claypole with Dickinson given the motivation above and the fact that both inventions are related to game machines with selection devices. Additionally the use of light pen and touch screen technology is well known as documented in both of the references used in the rejection.

Response to Arguments

3. Applicant's arguments with respect to claims 48-73 that the amended claims are in better form for allowance have been considered but are moot in view of the new ground(s) of rejection.

Citation of Pertinent Prior Art

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adams '974, Stanley '206, Farrell et al '433 are all related to a game machine with a secondary game,

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. HOTALING II
PRIMARY EXAMINER

April 8, 2004